

intermediate layer extends over at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe. This is clearly shown in the figures, e.g., Figure 5.

III. PATENTABILITY

Claim 1 was finally rejected in the original prosecution as being obvious over USP 5,191,727 (Barry et al) in view of USP 4,651,445 (Hannibal). The Board of Appeals reversed this rejection, as "We find no motivation in the references to do what the Examiner suggests." Bd. Decis., p. 5. More specifically, the Board stated, on page 6 of the decision:

While it may be true that the inner sole 30 comprising a composite laminate in Hannibal is structurally similar to the spring plate 20 comprising the composite laminate in Barry, the different orders of the layers in Hannibal *makes it difficult to see how its teachings are applicable to modify Barry.* (Emphasis added).

Thus, Barry et al and Hannibal are not combinable. New claims 28-29 clearly define over Barry et al. For example, Claim 28 merely clarifies Claim 1 and recites that the intermediate layer extends over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe. Claim 29 recites that the intermediate layer extends over at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe. There is no region of the sole directly beneath the users foot (e.g., the heel) which completely lacks an intermediate layer, and so the claimed intermediate layer is able to distribute shocks to the comfort layer over the full surface of the user's foot. In Barry et al, on the other hand, the spring plate 20 *does not extend at all*, directly beneath the lateral portion of the heel, and so cannot distribute shocks in this region of the foot, possibly leading to user discomfort.

IV. NO REISSUE RECAPTURE ESTOPPEL IS PRESENT

Reissue recapture estoppel is not present for Claims 28-29 since the claims are materially narrower than the scope surrendered during original prosecution. MPEP § 1412.02.

Patent Claim 1 derived from Application Claim 27. Paragraph (c) of application Claim 27 was amended as follows in the response filed on September 2, 1994:

c) an intermediate layer of said sole, arranged directly between an upper part of said ground contact layer, by one of its faces, and the lower part of said comfort layer by its other face, having controlled torsional and flecional rigidity, and providing both for the distribution of shockwaves and stresses sensed by said ground contact layer and for their diffusion over said comfort layer before coming in contact with the foot, said intermediate layer extending over an entire surface of said ground contact layer and constituting a framework [means] for the ground contact layer preventing deformation of the ground contact layer and thereby permitting it to be made of softer, more adherent rubber.

Applicants are not attempting to recapture a claim scope which is the same as that surrendered. Instead, the intermediate layer is limited in Claim 28 to substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe. In Claim 29 the intermediate layer is now limited to at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe. Both of these limitations as to the extent of the intermediate layer are materially narrower than the scope that was surrendered during the original prosecution.

[illegible]